REMARKS

Claims 15-25 are pending. Favorable reconsideration is respectfully requested.

The present invention relates to a method for preventing or treating pain , which comprises topically administering to a mammal an effective amount of a macrolide compound of the formula (I). See Claim 15.

The rejection of Claim 1 [sic; Claim 10] under 35 U.S.C. §102(b) over Herslof et al. is believed to be obviated by the amendment submitted above. Claim 1 has been amended to recite, inter alia, the subject matter of Claim 11, now canceled. Withdrawal of this ground of this ground of rejection is respectfully requested.

The rejection of Claims 10-12 under 35 U.S.C. §102(b) over Abu-Elmagd et al. is respectfully traversed. This reference fails to describe the claimed method.

In the Official Action, only the abstract of the Abu-Elmagd et al. publication was cited. A complete copy of the Abu-Elmagd et al. publication is enclosed in the Information Disclosure Statement (IDS) submitted herewith. Accordingly, all citations to Abu-Elmagd et al. refer to the complete copy of this publication enclosed with the IDS.

Abu-Elmagd et al. describe administering FK 506 orally to a patient with streaking leukocyte factor disease (see the Abstract and page 596, paragraph bridging columns 1 and 2). The reference fails to describe administering FK 506 topically. Accordingly, Abu-Elmagd et al. fail to describe the claimed method. Withdrawal of this ground of rejection is respectfully requested.

The rejection of Claims 13-14 under 35 U.S.C. §103(a) over Abu-Elmagd et al. in view of Rittenburg et al. is respectfully traversed. These references fail to describe the claimed method.

As discussed above, Abu-Elmagd et al. describe oral administration of FK 506 to a patient with streaking leukocyte factor disease. This reference fails to describe topical administration of FK 506.

Rittenberg et al. has been cited because the reference states:

> ...patients suffering from autoimmune diseases such as Systemic Lupus Erythmatosis (SLE) and rheumatoid arthritis (RA) are frequently prescribed long-acting oral immunosuppressive agents such as cyclosporin and FK506. [Column 9, lines 16-20.]

Rittenberg et al. describe a method of monitoring a therapeutic regimen in an animal (see the Abstract). This reference does not describe topically administration of macrolide compounds. In fact, the reference appears to be limited to orally administered active agents. See the Examples at columns 9-12, especially column 12, which describes oral administration of the macrolide cyclosporine.

Abu-Elmagd et al. and Rittenberg et al. fail to suggest optically administering a macrolide compound to prevent or treat pain.

Abu-Elmagd et al. teach oral administration of FK 506 to patient with streaking leukocyte factor disease. There is simply no suggestion or motivation from this reference to administer the FK 506 topically. In fact, Abu-Elmagd et al. explicitly state that low drug (i.e., FK 506) levels in the patient's plasma led to a reappearance of "focal subcutaneous areas of induration" (see page 596, column 2, lines 20-23). Thus, the suggestion in this reference is to keep plasma levels of the drug high. This would not be expected with topical administration of the FK 506. As discussed above, Rittenberg et al. does not appear to be

related to topical administration of macrolide compounds, since such compounds are administered orally and not topically.

Abu-Elmagd et al. and Rittenberg et al. fail to suggest the claimed method. Claims 15-25 are not obvious over these references. Withdrawal of this ground of rejection is respectfully requested.

Regarding the request for priority to UK 9814640, Applicants note that a copy of that application was submitted during the international phase. Moreover, the Form PCT/DO/EO/903 for this application indicates that the Office has received a copy of that priority application. Accordingly, Applicants submit that the present application is in compliance with 35 U.S.C. §119(b) and is entitled to the benefit of the filing date of UK 9814640.

Regarding the Abstract, Applicants note that the application as-filed has an Abstract at page 20. A copy of page 20 is attached for the Examiner's convenience.

Applicants submit that the application is in condition for allowance. Early notice to this effect is earnestly solicited.

Respectfully submitted,

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MARKED-UP COPY

Serial No.: 09/743,274
Amendment Filed On: October 5, 2001

IN THE SPECIFICATION

Please amend the specification as shown in the marked-up copy following this amendment.

Page 1, after the Title, please insert the following paragraph:

--This application is a National Stage of International Application Serial No. PCT/JP99/03602, filed on July 02, 1999.--

IN THE CLAIMS

Please cancel Claims 10-14.

Please add the following new claims.

--15. (New)

16. (New)

17. (New)

18. (New)

19. (New)

20. (New)

21. (New)

22. (New)

23. (New)

24. (New)

25. (New)--

ABSTRACT

Macrolide compounds, such as the FK506 Substance and its related compounds are provided for use as an analgesic, particularly, a topical analgesic. Composition containing such compounds is also disclosed.